

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 19, 22 and 24 will have been amended and claims 20-27 will be resubmitted for consideration by the Examiner. Thus, claims 19-27 remain pending in the present application. Applicant respectfully requests reconsideration of the outstanding rejections of the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided, and for conducting an interview by phone on June 3, 2005.

Additionally, Applicant again notes that an Information Disclosure Statement was filed in the present application on September 29, 1999. Accordingly, Applicant respectfully requests that the Examiner send a copy of the signed PTO-1449 Form attached to the Information Disclosure Statement to Applicant.

Turning to the merits of the action, the Examiner has rejected claim 19 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement, asserting the limitation "a file converter configured to convert image data into a predetermined plurality of file formats, the data of each file format including all of the image data" is not described in the specification.

Applicant notes that ST708 of Fig. 8 discloses "convert image to JFIF" and ST712 of Fig. 8 discloses "convert image to non-standard format". Thus, Applicant respectfully submits that ST708 and ST712 of Fig. 8 support the limitation "a file converter configured to convert image data into a predetermined plurality of file formats,

the data of each file format including all of the image data". The features of flowchart of Fig. 8 are performed by CPU1 of Fig. 1 (see. page 7, lines 8-9).

By the present amendment, Applicant has amended claim 19 to change the term "a file converter" in to the term ---a controller--- to clarify the scope of the subject matter. Thus, Applicant respectfully requests that the Examiner withdraw the rejection.

The Examiner has rejected claims 19, 20, 22, 24 and 25 under 35 U.S.C § 103(a), as being unpatentable over MURPHY (U.S. Patent No. 6,028,679) in view of European Patent Application EP 0 835 011 A1. The Examiner also rejected claims 21 and 23 under 35 U.S.C § 103(a), as being unpatentable over MURPHY (U.S. Patent No. 6,028,679) in view of European Patent Application EP 0 835 011 A1 and further in view of JP Publication 09-231121. The Examiner further rejected claim 19 under 35 U.S.C § 103(a) as being unpatentable over SAFAI et al. (U.S. Patent No. 6,167,469) in view of European Patent Application EP 0 835 011 A1. The Examiner further rejected claim 19 under 35 U.S.C § 103(a) as being unpatentable over JP Publication 09-231121 in view of European Patent Application EP 0 835 011 A1.

As noted above, Applicant has amended claims 19, 22 and 24 and resubmitted claims 20-27 with slight language revisions. Applicant respectfully traverses the above rejections based on the pending claims 19-27 and will discuss the rejection with respect to the pending claims in the present application as will be set forth hereinbelow. The amended and revised claims merely clarify the subject matter, but do not narrow the scope of the claims.

Applicant's invention, as disclosed, relates to an image data transmission system wherein a controller of a transmitting apparatus converts image data into a

predetermined plurality of file formats such that the data of each file format includes all of the image data. A transmitter determines the server corresponding to a recipient when an e-mail address of the recipient is input and transmits, to the server, the data in each of the plurality of file formats. Thus, the recipient can select from the server, the file format appropriate to it and extract the image data of the selected file format from the server.

Applicant's claims also relate to an image data transmitting apparatus that has a memory in which an e-mail address of a recipient and an address of a server corresponding to the e-mail address of the recipient are stored, and a controller that converts image data into a predetermined plurality of file formats, the data of each file format including all of the image data. The image transmitting apparatus includes a transmitter that determines the server corresponding to the recipient when the e-mail address of the recipient is input, transmits to the server the data in each of the predetermined plurality of file formats and transmits to the recipient, by e-mail, the address of the server in which the data in the predetermined plurality of file formats corresponding to the image data is stored. Thus, Applicant's transmitting apparatus includes the controller and the transmitter which transmits the plurality of data files to the server and the address of the appropriate server to the recipient. Thereby, the recipient accesses the server by using the address and selects, from the server, image data that is stored in a file format corresponding to the capability of the recipient.

Applicant's invention is also directed to an image receiving apparatus connected to an image transmitting apparatus through a network including at least one server. The server is configured to store image data to be received in a predetermined plurality

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of file formats, data of each file format including all of the of the image data. The image receiving apparatus receives an e-mail with an address of a server in which the image data to be received is stored, accesses the server by using said address to select image data that is stored in a file format corresponding to the capability of the image receiving apparatus and extracts the image data of said selected file format from said server.

As the Examiner admitted in the rejection issued on November 17, 2004 and June 16, 2005, MURPHY does not disclose at least “a memory configured to store an e-mail address of a recipient and an address of a server corresponding to the e-mail address of the recipient” and “a transmitter configured to determine the server corresponding to the recipient when the e-mail address of the recipient is input, to transmit to said server the data in each of the predetermined plurality of file formats and to transmit to said recipient, by e-mail, the address of the server in which the data in the predetermined plurality of file formats corresponding to the image data is stored.”

Thus, it is respectfully submitted that the features recited in Applicant's claims 19, 20, 22, 24, and 25-27 are not also disclosed in MURPHY cited by the Examiner.

Further, the Examiner asserts in the above rejections that EP 0 835 011 A1 discloses the shortcomings of MURPHY. However, this is incorrect. In EP 0 835 011 A1, NETFAX 1 scans image data, converts the image data into a single format, such as an HTML format, and stores the converted format in an external storage 14 (col. 5, lines 44-53, col. 6, lines 29-37, col. 7, lines 14-33). The seventh embodiment, to which the Examiner directs attention, has the same configuration as the first embodiment except for having no external storage 14 (col. 13, lines 25-51). However, the seventh

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embodiment also converts the image data into a single format. Thus, EP 0 835 011 A1 does not disclose at least “a transmitter configured to determine the server corresponding to the recipient when the e-mail address of the recipient is input, to transmit to said server the data in each of the predetermined plurality of file formats and to transmit to said recipient, by e-mail, the address of the server in which the data in the predetermined plurality of file formats corresponding to the image data is stored.” Thus, by using the teachings of EP 0 835 011 A1, the recipient cannot access the server by using the address and select, from the server, image data that is stored in a file format corresponding to the capability of the recipient. Therefore, the present invention is clearly distinguished over EP 0 835 011 A1.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 19, 20, 22, 24, and 25-27 are also not disclosed in EP 0 835 011 A1 cited by the Examiner. Further, the combinations of the pending claims are clearly distinct from combination of MURPHY and EP 0 835 011 A1, since both MURPHY and EP 0 835 011 A1 do not disclose at least a transmitter which transmits, to said server, the data in each of the predetermined plurality of file formats. Thus, it is respectfully submitted that the pending claims are submitted to be patentable over the Examiner's proposed combination.

Further, the Examiner has not set forth a proper motivation to combine MURPHY and EP 0 835 011 A1, since neither MURPHY nor EP 0 835 011 A1 discloses at least a transmitter which transmits, to said server, the data in each of the predetermined plurality of file formats.

Regarding the rejection of claims 21 and 23 under 35 U.S.C. § 103(a), as explained above, both MURPHY and EP 0 835 011 A1 do not disclose the features of the independent claims 19 and 22. Thus, since claims 21 and 23 are dependent from allowable independent claims 19 and 22, which are allowable for at least the reasons discussed above, these claims are also allowable for at least the these reasons. Further, all dependent claims recite additional features which further define the independent claims and provide additional bases for patentability.

Regarding the rejections of claims 22 and 25, the Examiner has asserted that arguments analogous to those presented for claim 19 are applicable. Applicant respectfully submits that the Examiner is incorrect. For example, claim 22 recites an extractor that selects image data that is stored in a file format corresponding to the capability of the image receiving apparatus. Claim 25 recites selecting image data that is stored in a file format corresponding to the capability of the image receiving apparatus. It is respectfully submitted that none of the references relied upon by the Examiner (in any proper combination) disclose these additional explicitly recited features of the claimed combinations. For this additional reason, Applicant respectfully submits that claims 22 and 25 are clearly patentable over the references relied upon by the Examiner.

Regarding SAFAI et al., the Examiner also admitted in the above rejection that SAFAI et al. does not disclose at least “a memory configured to store an e-mail address of a recipient and an address of a server corresponding to the e-mail address of the recipient” and “a transmitter configured to determine the server corresponding to the recipient when the e-mail address of the recipient is input, to transmit to said server the

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data in each of the predetermined plurality of file formats and to transmit to said recipient, by e-mail, the address of the server in which the data in the predetermined plurality of file formats corresponding to the image data is stored.” In addition, EP 0 835 011 A1 also does not disclose at least a transmitter which transmits, to said server, the data in each of the predetermined plurality of file formats, as discussed above. Thus, by using the teachings of EP 0 835 011 A1, the recipient cannot access the server by using the address and select, from the server, image data that is stored in a file format corresponding to the capability of the recipient. Therefore, the present invention is clearly distinguished over EP 0 835 011 A1.

Therefore, it is respectfully submitted that the combination of features recited in claim 19 are clearly distinct from combination of SAFAI et al. and EP 0 835 011 A1, since both SAFAI et al. and EP 0 835 011 A1 do not disclose at least a transmitter which transmits, to said server, the data in each of the predetermined plurality of file formats. Thus, It is respectfully submitted that the pending claims are submitted to be patentable over the Examiner’s proposed combination.

Further, the Examiner has not set forth a proper motivation to combine SAFAI et al. and EP 0 835 011 A1, since neither SAFAI et al. nor EP 0 835 011 A1 discloses at least a transmitter which transmits, to said server, the data in each of the predetermined plurality of file formats.

Regarding the JP Publication, the Examiner also admitted in the above rejection that the JP Publication does not disclose at least “a memory configured to store an e-mail address of a recipient and an address of a server corresponding to the e-mail address of the recipient” and “a transmitter configured to determine the server

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corresponding to the recipient when the e-mail address of the recipient is input, to transmit to said server the data in each of the predetermined plurality of file formats and to transmit to said recipient, by e-mail, the address of the server in which the data in the predetermined plurality of file formats corresponding to the image data is stored." In addition, EP 0 835 011 A1 also does not disclose at least a transmitter which transmits, to said server, the data in each of the predetermined plurality of file formats, as discussed above. Thus, by using the teachings of EP 0 835 011 A1, the recipient cannot access the server by using the address and select, from the server, image data that is stored in a file format corresponding to the capability of the recipient. Therefore, the present invention is clearly distinguished over EP 0 835 011 A1.

Therefore, it is respectfully submitted that the combination of features recited in claim 19 is clearly distinct from the combination of the JP Publication and EP 0 835 011 A1, since neither the JP Publication nor EP 0 835 011 A1 discloses at least a transmitter which transmits, to said server, the data in each of the predetermined plurality of file formats. Thus, it is respectfully submitted that the pending claims are submitted to be patentable over the Examiner's proposed combination.

Further, the Examiner has not set forth a proper motivation to combine the JP Publication and EP 0 835 011 A1, since both the JP Publication and EP 0 835 011 A1 do not disclose at least a transmitter which transmits, to said server, the data in each of the predetermined plurality of file formats.

Applicant further wishes to make of record a telephone interview conducted between Applicant's undersigned representative and Examiner Safaipour who is in charge of the present application on May 26, 2005.

Initially, Applicant's representative wishes to thank the Examiner for her cooperation in scheduling and conducting the above-noted interview. During the above-noted interview, the Examiner questioned the basis in the original disclosure of the file converter. During the interview, Applicant directed the Examiner's attention to various portions of the disclosure of the present application. In particular, the control aspect of the CPU 1 is disclosed at, *inter alia*, page 7, lines 8 and 9, and the plurality of formats are disclosed at, *inter alia*, page 8, lines 14-24, page 10, lines 3-16, page 12, lines 23-26 and page 13, lines 23-25. The Examiner attention is further directed to page 19, line 18- page 20, line 1.

The present Response, by changing "file converter" to "controller", together with the disclosure of above-noted portions of the present disclosure, clearly provide enablement for the recited claim features.

Applicant's representative respectfully thanks the Examiner for her time and effort in above-noted interview.

As noted above, contrary to the Examiner's assertions in the outstanding Official Action, the presently claimed invention is fully enabled, and neither of the primary references relied upon, nor any proper combination thereof, disclose the combination of features recited in Applicant's invention, even when considered in combination with the various secondary reference relied upon. In particular, none of the references disclose the converter as recited, e.g., in claim 19.

Moreover, the Examiner has not set forth a proper motivation for combining the features of the references utilized in the various rejections. In this regard, merely because two references relate to network facsimile communications does not

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automatically provide a motivation for their combination. Moreover, the Examiner asserted that combining the systems provides a capability of transmitting a plurality of file formats. However, neither of the references actually disclose transmitting a plurality of file formats, nor is there any reason based on the environments of either of these references, to assume that they actually do transmit a plurality of file formats.

The Examiner further asserts that the European Patent Application could be combined with MURPHY because "this addition would enhance the design". Of course, such an assertion by the Examiner without any evidence in the prior art supporting the same is applicable to any combination of references whatsoever. This is not a proper motivation required to support a rejection under 35 U.S.C. § 103.

For these additional reasons, it is respectfully submitted that each of the Examiner's rejections is inappropriate and that reconsideration and withdrawal of the outstanding rejections is appropriate.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and an indication of the allowability of all the claims pending in the present application in due course.

SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended claim 19 and resubmitted the claims for consideration by the Examiner. With respect to the pending claims, Applicant has pointed out the features thereof, as well as their basis in the original disclosure, and has contrasted the features of the pending claims with the disclosures of the references. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course. Applicant has also provided a record of an Interview conducted with the Examiner.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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